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IN THE

Supreme Court of the United States

October Term, 1962

No. 558

AERONAUTICAL COMMUNICATIONS EQUIPMENT, INC.,
Petitioner,

v.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Respondent.

PETITIONER'S REPLY BRIEF IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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Respondent concedes in its brief that the Petition for Writ of Certiorari should be granted with respect to Question 1 in so far as it deals with the '42 patent. However, Respondent contends that the Petition should be denied *in toto* with respect to patent '646 and as to Question 2 with respect to patent '642.

As to Question 1

Respondent's contention, unsupported by record references, is that there is no conflict of decisions with respect to patent '646.† This contention is manifestly erroneous as the following excerpts from the decision of the Court of Appeals for the Fifth Circuit and from the decision of the Court of Appeals for the First Circuit, printed at pages 6 and 7 of the petition, make apparent. The Court of Appeals for the Fifth Circuit held '646 valid, stating:

> "Having concluded that the trial court erred in holding that * * * the five claims of 2,133,646 were void or invalid for double patenting, was error [sic] we now decide that, the said defenses having failed, the said claims of the two patents are valid." (page 6 of Petition)

The Court of Appeals for the First Circuit held '646 invalid, stating:

> "Patent No. 2,133,646 covers the Pierce oscillator coupled to a harmonic selector or frequency multiplier circuit. * * *
>
> "We therefore conclude that the patent is void for double patenting over the 1,789,496 patent." (pages 7 and 8 of Petition)

Moreover, Respondent during its appeal to the Court of Appeals for the Third Circuit from the judgment holding '646 invalid, withdrew that patent. The result was that the interlocutory judgment as to that patent became final. Accordingly, the holding of validity of '646 by the

† Page 1 of Respondent's brief

Fifth Circuit Court of Appeals is also in direct conflict with the final judgment in the Third Circuit.

In any event it is obvious that there is a direct conflict as to the '646 patent between the decisions of the Court of Appeals for the Fifth Circuit and the Court of Appeals for the First Circuit. The Petition accordingly should be granted with respect to the '646 patent as well as with respect to the '642 patent.

As to Question 2

Respondent's contention with respect to Question 2 appears to be that since no Court of Appeals has passed upon the validity of '646 and '642 in the light of the prior art, Question 2 is moot.

However, it was the very failure of these Courts to pass upon validity which the Petitioner contends was erroneous neglect to heed the admonition of this Court as expressed in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327, 330 (1945), wherein the Courts below were instructed on the duty of "inquiring fully into the validity of the patent".

Moreover, if Respondent's contention is, as seems to be suggested,† that the validity of the patents in question in the light of the prior art was not raised in this case, its refutation is established by the Answer to the Complaint herein which asserted as a defense that:

† In footnotes 1 and 3 of Respondent's brief herein

"17. Each and all of said patents Nos. 2,133,642 * * * 2,133,646 * * * are invalid for the following reasons:

"(a) The subject described and claimed in each of said patents is lacking in patentable novelty."

On August 6, 1956, Petitioner served on Respondent notice of the prior art to be relied upon, the notice being filed under the provisions of 35 U.S.C. 282. The pertinent part of this notice reads as follows:

"Under the provisions of 35 U.S.C. 282, defendant hereby gives notice that at the trial of this action it will rely upon the following patents and publications to support the allegations of subparagraphs (a) and (f) of paragraph 17 of the Answer:

Patentee	*Patent No.*	*Date*
* * *	* * *	* * *
Cady	1,472,583	Oct. 30, 1923
* * *	* * *	* * *
Schelleng	1,545,607	July 14, 1925

Moreover, evidence concerning the Cady and Schelleng patents appears in the proceedings in the First and Third Circuits which were stipulated† and received in evidence in this case.

† See item 19, page 69, transcript of record below.

Conclusion

It thus appearing that the contentions which have been advanced by Respondent against the complete grant of the Petition for Writ of Certiorari are without merit, Petitioner renews its prayer that a writ of certiorari issue to the Court of Appeals for the Fifth Circuit for the reasons specified in the Petition.

Respectfully submitted,

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